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PATENT
Customer No. 22,852
Attorney Docket No. 06502.0435-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Bruce TOGNAZZINI) Group Art Unit: 3621
Application No.: 08/655,136) Examiner: Calvin L. HEWITT II
Filed: May 30, 1996)
For: CATALOG PHONE SALES)
TERMINAL)

Commissioner for Patents
Washington, DC 20231

Sir:

REQUEST FOR RECONSIDERATION

In reply to the Office Action dated October 31, 2002, the period for reply having been extended for one month by a request for extension of time and fee payment filed concurrently herewith, Applicant files this Request for Reconsideration.

In the Office Action, the Examiner allowed claims 5-10 and 15, and objected to claim 2. The Examiner also rejected claims 1, 3, 4, 11-14, and 17-20. In particular, the Examiner rejected claims 1, 3, 4, 18, and 19 under 35 U.S.C. § 102(b) as anticipated by Benton et al., U.S. Patent No. 4,625,276. The Examiner rejected claims 11, 12, 16, 17, and 20 under 35 U.S.C. § 103(a) as obvious in view of Benton et al.. Finally, the Examiner rejected claims 13 and 14 under 35 U.S.C. § 103(a) as obvious in view of Benton et al. and Haluska, U.S. Patent No. 5,638,519.

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Applicants appreciate the allowance of claims 5-10 and 15, and the indication of allowable subject matter in claim 2. Claim 2 depends from claim 1, which is allowable for at least the reasons given below. Thus, the objection to claim 2 as dependent on a rejected base claim should be withdrawn.

Rejections Under 35 U.S. C. § 102(e)

Claims 1, 3, 4, 18, and 19 were rejected under 35 U.S.C. § 102(b) as anticipated by Benton et al., U.S. Patent No. 4,625,276. To anticipate a claim, the reference must teach every element of the claim. M.P.E.P. § 2131.01 (9th ed. 2001). Because the reference does not disclose each and every element recited in claims 1, 3, 4, 18, and 19, the rejections under 35 U.S.C. § 102(b) should be withdrawn.

Regarding claim 1, Benton et al. fails to teach, among other things, a card reader. The reference discloses a portable module that may be optically aligned with a resident unit to send information to a remote location to enable electronic funds transfers. (Benton et al., col. 4, ll. 35-52; Fig. 4.) The portable module includes a display and a keyboard. (Benton et al., col. 4, ll. 59-63; Figure 4.) A user may enter information such as a personal identification number or a purchase amount using the keyboard of the portable module. (Benton et al., col. 5, ll. 58-59; col. 6, ll. 19-20.) However, neither the module nor the resident unit disclosed in the reference includes a card reader, as recited in claim 1.

Furthermore, Benton et al. fails to teach, among other things, a card reader for reading card information and sending it to a called station. The reference teaches a "credit" mode in which the portable module receives data such as a credit card number

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and credit card balance from a financial institution via an optical interface. (Benton et al., col. 8, ll. 26-33; col. 6, ll. 19-20.) However, nowhere does the reference mention a card reader for reading card information and sending it to a called station, as recited in claim 1.

Additionally, Benton et al. fails to teach a key for activating a data memory to send information received from one called station to another called station, as recited in claim 1. The reference teaches a series of communications between a buyer and a seller during a transaction. At the conclusion of the transaction, the seller's account number, transaction date, and transaction amount are stored in the buyer's module. (Benton et al., col. 6, ll. 28-66.) Nothing in the reference suggests that the stored information is sent to another party. Furthermore, the reference does not disclose a key for activating a data memory to send the stored information anywhere.

For at least the reasons given above, Benton et al. fails to disclose each and every element of claim 1. Therefore, the reference does not anticipate claim 1, and Applicant respectfully requests the reconsideration and allowance of claim 1.

Claims 3, 4, 18, and 19 depend from claim 1. Because Benton et al. does not disclose several elements of claim 1, the reference cannot disclose each and every element of the claims that depend therefrom. Thus, Applicant requests the reconsideration and allowance of claims 3, 4, 18, and 19.

Rejections Under 35 U.S. C. § 103(a)

Claims 11, 12, 16, 17, and 20 were rejected under 35 U.S.C. § 103(a) as obvious in view of Benton et al., and claims 13 and 14 were rejected under 35 U.S.C. § 103(a) as obvious in view of Benton et al. and Haluska. These rejections are traversed because a

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prima facie case of obviousness has not been made. To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. M.P.E.P. § 2143.03 (9th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist that the proposed modification will work for the intended purpose. Moreover, each of these requirements must "be found in the prior art, and not be based on applicant's disclosure." M.P.E.P. § 2143 (9th ed. 2001).

Regarding claim 11, Benton et al. fails to teach or suggest, among other things, storing card information received from a seller in memory located at a customer-site telephone. Instead, the reference discloses storing the seller's account number, transaction date, and transaction amount in the memory of the buyer's module after a transaction is completed. (Benton et al., col. 6, ll. 62-64.) This provides a record of the transaction at the buyer's module. However, this is not the same as storing card information received from a seller in memory at the customer-site telephone. Further, it would not have been obvious to modify Benton et al. to include this element because card information is not received from the seller at all in the reference. At least because Benton et al. fails to teach or suggest every element of claim 11, the claim is not obvious over the reference and Applicant requests the reconsideration and allowance of claim 11.

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Claims 12 and 20 depend from claim 11. Because claim 11 is nonobvious for at least the reasons given above, the claims that depend therefrom are nonobvious. Thus, Applicant requests the reconsideration and allowance of claims 11, 12, and 20.

Claim 16 includes similar recitations to claim 11 and was rejected for the same reasons. Therefore, Applicants request the reconsideration and allowance of claim 16 for at least the reasons given above with respect to claim 11.

Regarding claim 17, Benton et al. fails to teach or suggest, among other things, sending information from a seller to a customer for storage and use during a subsequent telephone purchase. Instead, the reference discloses storing the seller's account number, transaction date, and transaction amount in the memory of the buyer's module after a transaction is completed. (Benton et al., col. 6, ll. 62-64.) However, this is not the same as storing information received from a seller for use during a subsequent telephone purchase. Further, it would not have been obvious to modify Benton et al. to include this element because the information in the reference provides a record of a completed transaction. At least because Benton et al. fails to teach or suggest every element of claim 17, the claim is not obvious over the reference.

Regarding claim 13, Benton et al. fails to disclose determining whether a telephone of a customer is memory equipped. Instead, the reference teaches establishing communication between a buyer module and a seller module by determining whether communication is with another module or with a resident terminal. (Benton et al., col. 6, ll. 28-35.) Communication is established by checking for receipt of an optical character originating from another module instead of a resident terminal.

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(Benton et al., col. 8, ll. 63-66; col. 12, ll. 20-25.) This is not the same as determining whether a telephone of a customer is memory equipped. Furthermore, it would not have been obvious to make such a modification because in the reference, both the module and the resident terminal have memories. Thus, checking for a memory would be unnecessary in the system of Benton et al.

Haluska, which teaches electronic transaction tracking, does not cure the defects in the primary reference. Haluska teaches a series of computers (e.g., manufacturer computer 110 and distributor computer 130) sharing data about transactions. (Haluska, Fig. 1; Abstract.) Nothing in Haluska mentions a telephone at all, much less determining whether a telephone of a customer is memory equipped. At least because Benton et al. and Haluska, either separately or together, fail to teach or suggest every element of claim 13, the claim is not obvious over the references and Applicant respectfully requests the reconsideration and allowance of claim 13.

Claim 14 cannot be rejected as obvious because it depends from claim 13, which is nonobvious for at least the reasons given above. Therefore, Applicant requests the reconsideration and allowance of claim 13.

In view of the foregoing remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.

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Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: February 27, 2003

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